

REMARKS

Applicants submit this Amendment in reply to the Office Action dated August 4, 2003.

In this Amendment, Applicants have amended claims 1 and 5, rewritten claims 2, 4, 6, and 8 into independent form, and added new claims 9-14 to better define the claimed invention. Claims 1, 2, 4, 5, 6, and 8 are the sole independent claims.

Before entry of this Amendment, claims 1-8 were pending in this application. After entry of this Amendment, claims 1-14 are pending in this application.

The originally-filed specification, claims, abstract, and drawings fully support the subject matter of amended claims 1 and 5, rewritten claims 2, 4, 6, and 8, and new claims 9-14. No new matter was introduced.

In the Office Action, the Examiner rejected claims 1 and 5 under 35 U.S.C. §102(b) as being anticipated by Neal et al. (U.S. Patent No. 6,514,090 B1) ("Neal") and rejected claims 2-4 and 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Baur et al. (U.S. Patent No. 6,233,153 B1) ("Baur") in view of Neal. Applicants respond to these rejections as set forth in the following remarks.

The Examiner rejected claims 1 and 5 under 35 U.S.C. §102(b) as being anticipated by Neal. Applicants respectfully traverse this rejection. For anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or implicitly. M.P.E.P. 706.02. Because Neal does not teach every aspect of claims 1 or 5 either alone or in combination with the other aspects of the claimed invention, Neal does not anticipate any of those claims.

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Neal does not disclose or suggest the invention claimed in independent claims 1 or 5. For example, independent claims 1 and 5 recite a connection method and a connection structure, respectively, including, among other things, "at least three conductors." Neal does not disclose at least this aspect of the invention either alone or in combination with the other aspects of the claimed invention.

Specifically, Neal discloses an apparatus and method for enhancing the differential signaling speed performance of a PCI bus within a data processing system. This is at least partially done by splitting the single ended signal lines 202, 204 into differential signal line pairs 210a-210b and 212a-212b so as to reduce the electromagnetic field 208 and noise generated by the single ended signal lines 202, 204, and also to reduce the amount of energy expelled during the transfer of information on the bus for charging and discharging bus capacitances. (Col. 4, line 55 through col. 5, line 33). While Neal may disclose split vias 604, 801, 805 and split pins, 802, 803, (Figs. 6B, 7B) Neal does not disclose "at least three conductors." Indeed, Neal teaches against having at least three conductors, as having more than two conductors would create the same electromagnetic field, noise, and energy waste problems that Neal was trying to solve, and thus impermissibly destroy the purpose of the invention.

Accordingly, because Neal does not disclose every aspect of the invention either alone or in combination with the other aspects of the claimed invention, Applicants respectfully request the allowance of independent claim 1 and its respective dependent claims.]

The Examiner rejected claims 2-4 and 6-8 under 35 U.S.C. §103(a) as being unpatentable over Baur view of Neal. Applicants respectfully traverse this rejection.

Applicants initially note that “the examiner bears the initial burden, on review of the prior art on any other ground, of presenting a *prima facie* case of unpatentability.” In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis original). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references, when combined, must teach or suggest all of the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. §2143.

Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, not in Applicants’ disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Additionally, the evidence of teaching, suggestion, or motivation to combine must be “clear and particular.” In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). As will be described below, the combination of the cited references is improper, and thus the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. §103(a).

Applicants respectfully disagree with the Examiner’s arguments and conclusions, and submit that a *prima facie* case of obviousness has not been established. No proper combination of the cited references, including Baur, Neal, and the other art of record, teaches or suggests the present invention as claimed in claims 2-4 and 6-8.

For example, independent claims 2 and 6 recite, among other things, “wherein the first device is a cylinder head of an engine of an automobile, and the second device

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is an ignition coil device.” Contrary to the Examiner’s assertion on page 2 of the Office Action, Baur mentions neither a cylinder head nor an ignition coil anywhere in the specification, and additionally Neal does not remedy this deficiency of Baur. While Baur may mention “achieving a moisture-proof housing which is suitable to accommodate, e.g., ignition systems,” Baur does not show how the disclosed subassembly components correlate to either a cylinder head or an ignition coil, and the Examiner does not assert otherwise in the Office Action. Accordingly, because the Examiner has failed to meet the first criteria for *prima facie* obviousness with respect to claims 2 and 6, Applicants respectfully request allowance of these claims.

In another example, independent claims 4 and 8 recite, among other things, “annular seal members surrounding the fitting opening between the first device and the substrate and between the second device and the substrate.” Contrary to the Examiner’s assertion on page 2 of the Office Action, the aspect that Baur needs to disclose is not a seal between the two devices, but “between the first device and the substrate and between the second device and the substrate.” (Emphasis added). If, as the Examiner alleges, the first device is anticipated by the base plate 3, and substrate anticipated by the circuit board 2, and the first device anticipated by the cover 1, then as can be seen in Figs. 1 and 4A, Baur does not disclose anything, let alone anything that seals, between either the base plate 3 and the circuit board 2 or the cover 1 and the circuit board 2. All Baur discloses is that a part of the rim of the baseplate 3 is composed of a softer material to form a seal with the cover or lid 1. (Col. 4, line 67 through col. 5, line 9). Furthermore, Neal does not remedy this deficiency of Baur. Accordingly, because the Examiner has failed to meet the first criteria for *prima facie*

obviousness with respect to claims 4 and 8, Applicants respectfully request allowance of these claims.

Additionally, the Examiner asserted on pages 3 and 4 of the Office Action that "it would have been obvious to one having ordinary skill in the art at the time of the instant invention to provide such a feature [of Neal] to the Baur's device because this would provide a plurality of connections as shown by Neal." This is an improper motivation as it is neither clear and particular, as required by In re Dembiczak, nor found in the prior art, as required by In re Vaeck. Indeed, Applicants assert that it is not a motivation at all, but is simply an impermissible conclusory statement that adding an aspect of Neal to Baur will allegedly result in the claimed invention. Furthermore, Applicants assert that there is no motivation to combine the references, as Baur is directed to a subassembly for use in automobiles, while Neal is directed to method and apparatus for enhancing PCI bus performance in a data processing system. Accordingly, because the Examiner has failed to meet the second criteria for *prima facie* obviousness with respect to claims 2-4 and 6-8, Applicants respectfully request withdrawal of the §103(a) rejection.

Applicants further submit that claims 3, 7, and 9-14 depend from one of independent claims 1, 2, 4, 5, 6, and 8, and are therefore allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by Baur, Neal, or the cited art, and therefore at least some also are separately patentable.

In view of the foregoing remarks, this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this

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application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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